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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,002	09/08/2004	Robert H Bracewell	540-522	8862

23117 7590 01/28/2010

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ART UNIT	PAPER NUMBER
2123	

MAIL DATE	DELIVERY MODE
01/28/2010	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/507,002
Filing Date: September 08, 2004
Appellant(s): BRACEWELL, ROBERT H

Stanley C. Spooner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 20, 2009 appealing from the Office action mailed February 27, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellants' statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Jeff Conklin et al.; "gIBIS: A Hypertext Tool for Exploratory Policy Discussion", 1988, ACM Transactions on Office Information Systems, volume 6, number 4, pages 303 - 331

Hirose, U.S. Patent 5,784,286, 21 July 1998

W.C. Regli et al.; "A Survey of Design Rationale Systems: Approaches, Representation, Capture and Retrieval", 2000, Engineering with Computers, Volume 16, pages 209 – 235

Official Notice. Art used for taking of Official Notice:

- Kogan, U.S. Patent 5,809,317, 15 September 1998
- Nguyen, U.S. Patent 5,481,666, 2 January 1996

- Harald Weinreich et al., "The Look of the Link – Concepts for the User Interface of Extended Hyperlinks", 2001, Proceedings of the 12th ACM conference on Hypertext and Hypermedia, pages 19 – 28

- Michael I. Hyman et al., "Visual C++ 5 for Dummies", 1997, IDG Books Worldwide, pages 51 and 61

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. **Claims 1 - 2, 4 - 6, 8, 10, 15, 17, 18 - 19, 22, 33, 41, 47, 48, 50** are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin (Jeff Conklin et al.; "gIBIS: A Hypertext Tool for Exploratory Policy Discussion", art provided by the Applicant on the Information Disclosure Statement dated December 22, 2004) in view of Hirose (U.S. Patent Number 5,784,286) further in view of Regli (W.C. Regli et al.; "A Survey of Design Rationale Systems: Approaches, Representation, Capture and Retrieval", 2000, Engineering with Computers, Volume 16, pages 209 - 235).

a. The art of Conklin is directed to a design knowledge capture tool (*unnumbered first page assumed to be page 303*).

b. The art of Hirose is directed to a design knowledge capture tool (*column 2, lines 65 - 67*).

c. The art of Regli is directed to a design rationale capture tools (*page 209, Abstract*).

d. The art of Conklin and the art of Regli are analogous art because they are both directed to the art of a design knowledge capture tools.

e. The art of Conklin and the art of Hirose are analogous art because they are both directed to the art of a design knowledge capture tool.

f. Regarding **claim 1**:

g. Conklin appears to teach:

h. a storage means for storing design knowledge information generated or acquired during progress of a first design project, wherein the design knowledge information extends beyond product design information and includes information on evolution of a first design project and causal dependencies between items of said design knowledge (*pages 304 - 305, section 2. THE IBIS METHOD, and page 305, figure 1; it would have been obvious that a storage means was used to store the information*) said storage means comprising a plurality of *records* ~~files, each file~~ having a predefined knowledge structure for including a list of issues to be addressed (*page 305, figure 1, box labeled "issue"; figure 1 displays an entity-relationship diagram, and the ordinary artisan would have known that elements of an entity-relationship diagram were stored as records with predefined structure*);

i. an input means for allowing a user to input information into the storage means (*page 308, figure 5, and explanatory text on page 307,fourth paragraph that starts with, "In this example . . ."*);

j. A presentation means for presenting a file template ~~of each of said plurality of files~~ to the user to allow the information to be input by the user in said predefined knowledge structure (*page 308, figure 5, and explanatory text on page 307,fourth paragraph that starts with, "In this example . . .", and fifth paragraph; and page 306, figure 2*), wherein said presentation means presents each said structure as an array of nodes, each node representing an item of said design knowledge (*page 306, figure 2, left-side panel of the window displays an array of nodes, each node representing an item of knowledge design*), wherein a dependency between items of said design knowledge is represented by a directed link between selected nodes (*page 306, figure 2, left-side panel of the window displays an array of nodes with links*), ~~wherein said directed link is bi-directional to permit a user to traverse the link in either direction~~, and wherein said selected nodes represent items of design knowledge (*page 306, figure 2, left-side panel of the window displays an array of nodes, each node representing an item of design knowledge*) ~~stored in different files~~.

k. Conklin does not specifically teach:

l. said storage means comprising a plurality of ~~records~~ files, each file ~~having a predefined knowledge structure for including a list of issues to be addressed~~;

m. ~~A presentation means for presenting a file template~~ of each of said plurality of files ~~to the user to allow the information to be input by the user in said predefined knowledge structure, wherein said presentation means presents each said structure as an array of nodes, each node representing an item of said design knowledge, wherein a dependency between items of said design knowledge is represented by a directed link between selected nodes,~~ wherein said directed link is bi-directional to permit a user to traverse the link in either direction, ~~and wherein said selected nodes represent items of design knowledge~~ stored in different files.

n. Hirose appears to teach:

o. presenting a file template of each of said plurality of files (*figure 6A; it would have been obvious to the ordinary artisan to use multiple windows for a display*).

p. said storage means comprising a plurality of ~~records~~ files, each file having a predefined knowledge structure (*figure 5, elements stage records, focus records, sketch/drawing model, and column 7, lines 20 - 35 which recites three "stores"*) ~~for including a list of issues to be addressed~~

q. Regli appears to teach:

r. said storage means comprising a plurality of ~~records~~ files, each file having a predefined knowledge structure (*page 213, figure 2, left-side box labeled "Design Repositories" contains a plurality of files, each file having a predefined knowledge structure*).

s. design knowledge stored in different files (*page 213, figure 2, left-side box labeled "Design Repositories" contains a plurality of files, each file having a predefined knowledge structure*).

t. Official Notice is taken that it was well known at the time of invention in the analogous art of linking electronic documents that a directed link was bidirectional to permit a user to traverse the link in either direction. At the time of invention, it would have been obvious to the ordinary artisan to provide the limitation, "wherein said directed link is bi-directional to permit a user to traverse the link in either direction". The motivation would have been the major advantage that hyperlinks provide the ability to establish and maintain arbitrary associations between various stored documents. The following references are provided to support the Official Notice:

i. Kogan (U.S. Patent Number 5,809,317) teaches bi-directional hyperlinks (*column 4, lines 35 – 55, and column 1, lines 65 – 67, and column 2, lines 1 - 2*);

ii. Nguyen (U.S. Patent Number 5,481,666) teaches bi-directional hyperlinks (*column 4, lines 35 - 40*);

iii. Harald Weinreich et al., "The Look of the Link – Concepts for the User Interface of Extended Hyperlinks", 2001, Proceedings of the 12th ACM conference on Hypertext and Hypermedia, pages 19 – 28; teaches bi-directional hyperlinks (*page 22, left-side column, section "Bi-directional Links"*);

u. The motivation to use the art of Hirose with the art of Conklin would have been the benefits recited in Hirose including a cost effective, useful and inexpensive design process recorder that benefits design and redesign (*column 4, lines 9 - 20*).

v. The motivation to use the art of Regli with the art of Conklin would have been the benefit recited in Regli that keeping track of design rationale will provide a great aid to designers, and provides a basis for designers to explore more design options (*page 209, right-side column, second paragraph that starts with, "Usually a developed . . ."*).

w. Therefore, as discussed above, it would have been obvious to the ordinary artisan at the time of invention to use the art of Hirose and the art of Regli and Official Notice with the art of Conklin to produce the claimed invention.

x. Regarding **claims 33, 41, 47, 48, 50**:

y. Conklin appears to teach:

z. A method for capturing design knowledge information wherein the information extends beyond product design information and includes information on evolution of a first design project and causal dependencies between items of design knowledge (*page 305, figure 1; and page 306, figure 2*);

aa. storing the information generated or acquired during progress of a first design project in a storage means (*pages 304 - 305, section 2. THE IBIS METHOD, and page 305, figure 1; it would have been obvious that the information was stored*), said storage means comprising a plurality of *records* ~~files, each file~~ having a predefined knowledge structure for including a list of issues to be addressed (*page 305, figure 1, box labeled "issue"; figure 1 displays an entity-relationship diagram, and the ordinary artisan would have known that elements of an entity-relationship diagram were stored as records with predefined structure*);

bb. ~~selecting one of said files~~ and presenting a file template ~~of each of said plurality of files~~ to the user to allow the information to be input by the user in said predefined knowledge structure (*page 308, figure 5, and explanatory text on page 307,fourth paragraph that starts with, "In this example . . .", and fifth paragraph; and page 306, figure 2*), each structure being presented as an array of nodes, each node representing an item of said design knowledge (*page 306, figure 2,*

left-side panel of the window displays an array of nodes, each node representing an item of knowledge design), wherein a dependency between items of said design knowledge is represented by a directed link between selected nodes (*page 306, figure 2, left-side panel of the window displays an array of nodes with links*), ~~wherein said directed link is bi-directional to permit a user to traverse the link in either direction~~, and wherein said selected nodes represent items of design knowledge (*page 306, figure 2, left-side panel of the window displays an array of nodes, each node representing an item of design knowledge*) ~~stored in different files and~~ inputting information into said file (*page 308, figure 5, and explanatory text on page 307,fourth paragraph that starts with, "In this example . . ."*).

cc. Conklin does not specifically teach:

dd. ~~said storage means comprising a plurality of records~~ files, each file ~~having a predefined knowledge structure for including a list of issues to be addressed~~;

ee. selecting one of said files ~~and presenting a file template~~ of each of said plurality of files ~~to the user to allow the information to be input by the user in said predefined knowledge structure, each structure being presented as an array of nodes, each node representing an item of said design knowledge, wherein a dependency between items of said design knowledge is represented by a directed link between selected nodes~~, wherein said directed link is bi-directional to permit a user to traverse the link in either direction, ~~and wherein said selected nodes represent items of design knowledge~~ stored in different files and ~~inputting information into said file~~;

ff. Hirose appears to teach:

gg. said storage means comprising a plurality of ~~records~~ files, each file having a predefined knowledge structure (*figure 5, elements stage records, focus records, sketch/drawing model, and column 7, lines 20 - 35 which recites three "stores"*) ~~for including a list of issues to be addressed.~~

hh. presenting a file template of each of said plurality of files (*figure 6A; it would have been obvious to the ordinary artisan to use multiple windows for a display*).

ii. Regli appears to teach:

jj. said storage means comprising a plurality of ~~records~~ files, each file having a predefined knowledge structure (*page 213, figure 2, left-side box labeled "Design Repositories" contains a plurality of files, each file having a predefined knowledge structure*).

kk. design knowledge stored in different files (*page 213, figure 2, left-side box labeled "Design Repositories" contains a plurality of files, each file having a predefined knowledge structure*).

ll. Official Notice is taken that it was old and well known by the ordinary artisan at the time of invention to select one of a plurality of files in the analogous art of software development. At the time of invention, it would have been obvious to an ordinary artisan to select one of a plurality of files as a design knowledge base. The motivation would have been the knowledge of the ordinary artisan that there would be more than one design knowledge base, and the application program of Conklin would need to select a knowledge base file to use. In support of the Official Notice, please refer to the reference, by Michael I. Hyman et al., "Visual C++ 5 for Dummies", 1997, IDG Books Worldwide, pages 51 and 61 which display a file open menu and a list of files from which to select.

mm. Therefore, as discussed above, it would have been obvious to the ordinary artisan at the time of invention to use the art of Hirose and the art of Regli and Official Notice with the art of Conklin to produce the claimed invention.

nn. Official Notice is taken that it was well known at the time of invention in the analogous art of linking electronic documents that a directed link was

bidirectional to permit a user to traverse the link in either direction. At the time of invention, it would have been obvious to the ordinary artisan to provide the limitation, "wherein said directed link is bi-directional to permit a user to traverse the link in either direction". The motivation would have been the major advantage that hyperlinks provide the ability to establish and maintain arbitrary associations between various stored documents. The following references are provided to support the Official Notice:

i. Kogan (U.S. Patent Number 5,809,317) teaches bi-directional hyperlinks (*column 4, lines 35 – 55, and column 1, lines 65 – 67, and column 2, lines 1 - 2*);

ii. Nguyen (U.S. Patent Number 5,481,666) teaches bi-directional hyperlinks (*column 4, lines 35 - 40*);

iii. Harald Weinreich et al., "The Look of the Link – Concepts for the User Interface of Extended Hyperlinks", 2001, Proceedings of the 12th ACM conference on Hypertext and Hypermedia, pages 19 – 28; teaches bi-directional hyperlinks (*page 22, left-side column, section "Bi-directional Links"*);

oo. Regarding **claim 2**:

pp. Conklin appears to teach:

qq. An interactive graph editor (*page 306, figure 2*).

rr. Regarding claim 4:

ss. Conklin appears to teach:

tt. in use, a user is prompted by the knowledge structure, to input at least one possible answer to at least one of said issues, the at least one possible answer being stored as one of the, or each, piece of

information at the label of the node (*page 307, last paragraph, extending on to page 308, and page 308, figure 5*).

uu. Regarding claim 5:

vv. Conklin appears to teach:

ww. the knowledge structure prompts the user to input at least one argument that supports or refutes the possible answer, the at least one argument being stored as one of the, or each, piece of information at the label of the node (*page 305, figure 1, especially the box labeled "argument", and page 307, last paragraph, extending on to page 308, and page 308, figure 5*).

xx. Regarding claim 6:

yy. Conklin appears to teach:

zz. the at least one argument is classified as a supporting or a refuting argument (*page 305, figure 1, especially the links labeled "supports" and "objects-to"*).

aaa. Regarding claim 8:

bbb. Conklin appears to teach:

ccc. said at least one argument is classified as a valid or an invalid argument (*page 312, figure 11, graph config parameters, element "argument display bias"*).

ddd. Regarding claim 10:

eee. Conklin appears to teach:

fff. the at least one answer is classified as an open, an accepted or rejected answer (*page 305, second paragraph; answers are open*).

ggg. Regarding claim 15:

hhh. Conklin appears to teach:

iii. each node appears once only in the *predefined file* ~~plurality of files~~ (*page 306, figure 2*).

jjj. Conklin does not specifically teach:

kkk. A plurality of files.

lll. Regli appears to teach:

mmm. A plurality of files (*page 213, figure 2, left-side box labeled "Design Repositories" contains a plurality of files*).

nnn. Regarding claim 17:

ooo. Conklin does not specifically teach:

ppp. the, or each, node can be linked to an additional node on the same file.

qqq. Regli appears to teach:

rrr. the, or each, node can be linked to an additional node on the same file (*page 224, section 6.1 Navigating Archived Design Rationale, and page 213, left-side column, third paragraphs, REMAP/MM [26] supports hyper-links; it would have been obvious that hyper-links could be linked to a node on the same file*).

sss. Regarding claim 18:

ttt. Conklin appears to teach:

uuu. a sub-issue to the at least one predefined issue can be identified and input into the storage means (*page 305, figure 1, links to the box "issue", labeled "REPLACES, QUESTIONS OR IS-SUGGESTED-BY"*).

vvv. Regarding claim 19:

www. Conklin appears to teach:

xxx. a user is prompted to input at least one possible answer to the sub-issue (*page 307, last paragraph, extending on to page 308, and page 308, figure 5*).

yyy. Regarding claim 22:

zzz. Conklin does not specifically teach:

aaaa. a processing means to identify at least one predefined issue addressed on a first design project, which issue is encountered on a subsequent design project.

bbbb. Regli appears to teach:

cccc. a processing means to identify at least one predefined issue addressed on a first design project, which issue is encountered on a subsequent design project (*page 210, right-side column, last sentence, extending on to page 211, and page 224, section 6.1 Navigating Archived Design Rationale, and page 213, left-side column, third paragraphs, REMAP/MM [26] supports hyper-links; it would have been obvious that hyper-links could be linked to a node on a subsequent design project*).

2. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the Applicant in preparing responses, to fully consider the references in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. *The entire reference is considered to provide disclosure relating to the claimed invention.*

(10) Response to Argument

Regarding Applicant's arguments on pages 6 - 8 under the heading "ARGUMENT", the Examiner respectfully replies:

The Appellant's comments appear to be an introduction with no arguments.

Regarding Applicant's arguments on pages 8 - 11 under the heading "A. The Examiner's contention that one of Conklin, Hirose and Regli teaches the claim limitation "said directed link is bi-directional to permit a user to traverse the link in either direction" is still incorrect", the Examiner respectfully replies:

The Appellant asserts that none of the references contain any objective teaching of the claimed bi-directional "directed link". The Examiner respectfully replies that Official Notice was used to teach the limitation rather than the references of Conklin, Hirose and Regli. As discussed in MPEP 2144.03, Official Notice may be taken where the facts are capable of instant and unquestionable demonstration as being well-known, and the facts are of notorious character and serve only to "fill in the gaps". Further, documentary support of the Official Notice is provided by citation to references by Kogan, Nguyen and Weinreich.

The Appellant traverses the Official Notice, and asserts that none of the references used to support the Official Notice (Kogan, Nguyen, and Weinreich) teach the claimed bi-directional link. However, the Appellant then continues and admits that the Kogan reference discloses bi-directional links. The Appellant then continues and admits that systems are well known that have hyperlinks that are bi-directional, meaning it can be traversed in either direction. The Examiner respectfully replies that the Appellant admits that Kogan teaches bi-directional links, which supports the Official Notice.

The Appellant argues that there is nothing in Kogan which suggests how the general feature of the claimed directed link could be applied, especially to selected nodes representing

items of design knowledge stored in different files. The Examiner respectfully replies that Kogan is directed to maintaining hypertext links (title and abstract), and a person of ordinary skill is also a person of ordinary creativity, not an automaton, and thus would have known how to implement the bi-directional hyperlinks of Kogan.

The Appellant argues that Nguyen does not teach bi-directional hyperlinks. The Examiner respectfully replies that Nguyen teaches bi-directional hyperlinks in column 4, lines 10 - 40. Further, because Kogan teaches bi-directional links, the Nguyen reference is additive.

The Appellant argues that Weinreich teaches bi-directional linking, but teaches away from their use in graphical maps (see last three lines of the section entitled "Bi-directional links"). The Examiner respectfully replies that Weinreich merely teaches that the "approaches have their limitations", which does not criticize, discredit or otherwise discourage the solution, and thus does not teach away from bi-directional links. Weinreich proceeds to discuss methods to overcome the limitations.

The Appellant argues that the Examiner has failed to establish where each claimed structure is disclosed in a combination of prior art references. The Examiner respectfully replies that the rejections in the Office action recited the location of the claim limitations, and the arguments are merely unsubstantiated allegations without supporting argument or rationale.

Regarding Applicant's arguments on pages 11 - 12 under the heading "B. The Examiner's fails to provide any rationale for combining bits and pieces of the three cited references and then combining them in the manner of Appellant's independent claims", the Examiner respectfully replies:

The Appellant argues that the Examiner provides general benefits of the prior art references as a motivation for combining portions of the references, but there is no recognition that they can be combined in the manner of the pending claims or that they would provide the benefit disclosed in the pending application. The Examiner respectfully replies that as recited in the rejection, the motivation for combining the teachings of Hirose would have been the benefits recited in Hirose, "cost effective, useful and inexpensive design recorder that benefits design and redesign". Further, as recited in the rejection, the motivation for combining the teachings of Regli with Conklin would have been the benefits recited in Regli, "keeping track of design rationale will provide a great aid to designers, and provides a basis for designers to explore more design options", which would have been recognized as a benefit by the ordinary artisan. Thus, the ordinary artisan would have been motivated to combine the teachings of the recited references to produce the claimed invention. The MPEP 2143.01 recites that obviousness can be established by combining the teachings of the prior art to produce the claimed invention where there is some motivation to do so. The references provide motivation that would have led one of ordinary skill to combine prior art reference teachings to arrive at the claimed invention, and thus a proper prima facie case of obviousness is provided.

The Appellant argues that the Examiner provides no analysis and therefore fails to meet the KSR requirements of a prima facie case of obviousness. The Examiner respectfully replies that as discussed above, a motivation to combine the teachings of the references is provided, and thus a proper prima facie case of obviousness is provided. Further, the Examiner may also take into account the inferences and creative steps that a person of ordinary skill in the art would employ. An ordinary artisan is also a person of ordinary creativity, not an automaton.

The Appellant argues that the benefits in Hirose have nothing to do with the elements being chosen from Hirose and suggested to be combined with other specific elements of Conklin. The Examiner respectfully replies that as discussed above, a motivation to combine the teachings of the references is provided, and thus a proper prima facie case of obviousness is provided. Further, the Examiner may also take into account the inferences and creative steps that a person of ordinary skill in the art would employ.

The Appellant argues that there is no indication as to why one of ordinary skill in the art would ignore the contrary teachings in the Hirose and Conklin references, and thus the Examiner is making a conclusory statement. The Examiner respectfully replies that the Appellant does not specify the alleged contrary teachings, and the motivation recited in the rejection recites benefits that would have provided a motivation to combine the teachings of the references, and thus a proper prima facie case of obviousness is provided.

The Appellant argues that the Examiner simply fails to provide any reason to pick and choose the "directed link" with the other elements of the Conklin references and the Hirose reference, and then combine them in the manner claimed. The Examiner respectfully replies that the Official Notice relied upon in the rejection establishes that the "directed link" was of well-known in the art. As discussed in MPEP 2144.03, Official Notice may be taken where the facts are capable of instant and unquestionable demonstration as being well-known, and the facts are of notorious character and serve only to "fill in the gaps". Further, documentary support of the Official Notice is provided by citation to references by Kogan, Nguyen and Weinreich.

The Appellant argues that the Examiner uses hindsight reasoning. The Examiner respectfully replies it must be recognized that any judgment on obviousness is in a sense

necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding Applicant's arguments on page 13 under the heading "C. The Examiner's does not cite any portion of the Kogan, Nguyen and Weinreich references which he alleges contains "bi-directional hyperlinks", as teaching the claimed "directed link" as defined in the claims", the Examiner respectfully replies:

The Appellant argues that the Examiner has not indicated how or where Kogan, Nguyen or Weinreich teach Appellant's claimed "directed link" instead of the Examiner's hyperlink. The Examiner respectfully replies that the Examiner's hyperlink is a bi-directional "directed link", as recited in the rejection.

The Appellant argues that there is no evidentiary disclosure for a claimed element if the Examiner cannot point out where or how a prior art reference teaches a directed link between selected nodes which is bi-directional to permit a user to traverse the link in either direction, and wherein said selected nodes represent items of design knowledge stored in different files. The Examiner respectfully replies that the Official Notice in the rejection recites references that teach a directed link between selected nodes which is bi-directional to permit a user to traverse the link in either direction. The limitation wherein said selected nodes represent items of design knowledge stored in different files is taught in the rejection by Conklin and Regli. Further,

obviousness must be determined in light of knowledge of the ordinary artisan, and the Examiner respectfully remarks that Conklin shows on page 306, figure 2, trees of design elements, the design elements connected by links, where each link may be traced with one's finger from the parent element to the child element, and back again to the parent, which appears to be bi-directional. A reference only needs to impliedly suggest a limitation.

Regarding Applicant's arguments on pages 13 - 14 under the heading "D. The Examiner fails to evidence any support for a prima facie case of obviousness", the Examiner respectfully replies:

The Appellant's comments appear to be an introduction with no arguments.

Regarding Applicant's arguments on pages 14 - 15 under the heading "1. The Examiner fails to meet his evidentiary burden of establishing that the prior art teaches all claimed elements", the Examiner respectfully replies:

The Appellant argues that Kogan, Nguyen and Weinreich do not support the Examiner's contention that bi-directional directed links are well known in the art, and thus the Examiner fails to show where the claimed elements are disclosed in the cited prior art, and therefore, there is not support for a prima facie case of obviousness. The Examiner respectfully replies that as recited in the rejection, the references by Kogan, Nguyen and Weinreich support that bi-directional directed links are well known in the art, as follows: Please see Kogan (*column 4, lines 35 - 55, and column 1, lines 65 - 67, and column 2, lines 1 - 2*), and Nguyen (*column 4, lines 10 - 40*), and Weinreich (*page 22, left-side column, section "Bi-directional links"*).

Regarding Applicant's arguments on pages 16 - 18 under the heading "2. The Examiner fails to identify any evidence or provide any explicit "analysis" as to why one of ordinary skill in the art would pick and choose elements or method steps from the prior art references and then combine them in the manner of Appellant's claims", the Examiner respectfully replies:

The Appellant argues that the Examiner on page 14, sub-sections u, v, and w, merely provides his speculations as to benefits possibly motivating combination of references. The Examiner respectfully replies that the sub-sections u , v and w refer to benefits recited in the references by Hirose and Regli. Specifically the benefits recited in Hirose include a cost effective, useful and inexpensive design process recorder that benefits design and redesign (see Hirose, column 4, lines 9 - 20), and the benefits recited in Regli include that keeping track of design rationale will provide a great aid to designers, and provides a basis for designers to explore more design options (see Regli, page 209, right-side column, second paragraph).

The Appellant argues that the benefits disclosed in the Hirose reference, "a cost effective, useful and inexpensive design process recorder" is a mere conclusory statement. The Examiner respectfully replies that the recited benefit is recited in Hirose (see Hirose, column 4, lines 9 - 20), and thus is not a conclusory statement.

The Appellant argues that there is no required analysis by the Examiner that there is some benefit in picking and choosing elements from Hirose, from Conklin and from Regli and for combining those individual elements in the manner of Applicant's independent claims 1 or 33. The Examiner respectfully replies that as discussed above, a motivation to combine the teachings

of the references is provided, and thus a proper prima facie case of obviousness is provided. Further, the Examiner may also take into account the inferences and creative steps that a person of ordinary skill in the art would employ. An ordinary artisan is also a person of ordinary creativity, not an automaton.

The Appellant argues that it is insufficient for the Examiner to merely generally allege that the prior art combination is a "cost effective, useful and expensive [sic] design process recorder" or is a "great aid to designers, and provides a basis for designers to explore more design options" or that it would be "obvious to the ordinary artisan at the time of invention to use the art of Hirose and the art of Regli and Official Notice with the art of Conklin to produce the claimed invention. The Examiner respectfully replies that, as discussed above, the benefits of "cost effective, useful and expensive [sic] design process recorder" or is a "great aid to designers, and provides a basis for designers to explore more design options" are recited in the references. Further, the recited conclusion of obviousness is based upon the benefits that provide motivation to combine the teachings of the references and the teachings of the references themselves.

The Appellant argues that the Examiner does not meet the test of the Supreme Court's requirement for an explicit "analysis" as to the reasons for picking and choosing elements from the cited prior art references and then for combining them specifically in the manner of the Appellant's claims, and thus, the Examiner has failed to meet the second prong of the prima facie case of obviousness test. The Examiner respectfully replies that as discussed above, a motivation to combine the teachings of the references is provided, and thus a proper prima facie case of obviousness is provided. The MPEP 2143.01 recites that obviousness can be

established by combining the teachings of the prior art to produce the claimed invention where there is some motivation to do so. The references provide motivation that would have led one of ordinary skill to combine prior art reference teachings to arrive at the claimed invention, and thus a proper prima facie case of obviousness is provided.

Regarding Applicant's arguments on pages 18 - 20 under the heading "3. The Examiner apparently fails to appreciate that Weinreich specifically teaches away from the cited prior art combination", the Examiner respectfully replies:

The Appellant argues that Weinreich teaches away from the use of a bi-directional link in graphical maps in the last three lines of the section entitled "Bi-directional links". The Examiner respectfully replies that Weinreich merely teaches that the "approaches have their limitations", which does not criticize, discredit or otherwise discourage the solution, and thus does not teach away from bi-directional links. Weinreich proceeds to discuss methods to overcome the limitations.

The Appellant argues that Weinreich indicates that such a system "poses a serious problem". The Examiner respectfully replies that the recited "serious problem" refers to retrieval of links that refer to the current document for the Web, but then Weinreich proposes solutions to the problem. Thus Weinreich does not discourage the solution, and thus does not teach away from bi-directional links.

The Appellant argues that Weinreich teaches that graphical maps use a lot of screen space if dozens of nodes and links are displayed, thereby teaching away from the Appellant's claimed

"presentation means for presenting a file template of each of said plurality of files to the user to allow the information to be input by the user in said predetermined knowledge structure". The Examiner respectfully replies that the Appellants conclusion does not appear to follow logically from the premises, at least because there is no limitation in the Appellant's claim that recites dozens of nodes and links. Further, Weinreich proceeds to discuss methods to overcome the limitations.

The Appellant argues that the elements "a directed link between selected nodes" and a directed link that is "bi-directional to permit a user to traverse the link in either direction" are not disclosed in Weinreich. The Examiner respectfully replies that Weinreich teaches a bi-directional link to permit a user to traverse the link in either direction, as recited in the rejection, at page 22, section "Bi-directional links". As recited in the rejection, Conklin teaches "a directed link between selected nodes" at least on page 306, figure 2, left-side panel of the window, which displays directed links between selected nodes.

The Appellant argues that Weinreich would tend to at least lead those of ordinary skill in the art away from the claimed combination of elements. The Examiner respectfully replies that Weinreich merely teaches that the "approaches have their limitations", which does not criticize, discredit or otherwise discourage the solution, and thus does not teach away from bi-directional links. Weinreich proceeds to discuss methods to overcome the limitations.

The Appellant teaches that the evidence that Weinreich teaches away from the combination rebuts any prima facie case of obviousness. The Examiner respectfully replies that, as discussed above, Weinreich does not teach away from the combination, and thus a prima facie case of obviousness has been established. Further, Weinreich is merely additive to the references

of Kogan and Nguyen, and thus a teaching away in Weinreich alone cannot overcome the prima facie case of obviousness.

Regarding Applicant's arguments on pages 20 - 21 under the heading "Conclusion", the Examiner respectfully replies:

The Appellant argues that the Examiner alleges only that the prior art references "appear" to teach claimed features, but "appears to teach" is not the standard of obviousness. The Examiner respectfully replies that the phrase, "appears to teach", is a polite form of "teaches", and should be read as "teaches or reasonably suggests".

As discussed above, the Appellants' arguments are not persuasive, and the rejections should be upheld.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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